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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/801,401  
Filing Date: March 15, 2004  
Appellant(s): CLEMENTS, JEHAN

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Blake Reese  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/30/2009, and amended 12/4/2009, appealing from the Office action mailed 3/4/2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2002/0161603 A1	Gonzales	10-2002
US 6,126,202 A	Scocca	10-2000
US 6,210,172 B2	Clements	4-2001
US 5,127,879 A	Schubert	7-1992
US 5,397,156 A	Schach	3-1995

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21-24 & 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales (US 2002/0161603 A1), hereinafter known as Gonzales, and further in view of Scocca (US 6,126,202 A), hereinafter known as Scocca, Clements (US 6,210,172 B2), hereinafter known as Clements '172, and Schubert (US 5,127,879 A), hereinafter known as Schubert.

Gonzales teaches a storytelling book and method of providing a storytelling book (interactive publishing system, Para. 0032; method, Para. 0043-44), comprising: operating a software program in a computer (computer system, Para. 0037) having subroutines for (a) accepting a first set of inputs from a user in a first graphical user interface screen and providing them to the software program (an Author can create an article, etc., Para. 0068-78), the first set of inputs comprising title information (Figure 6, Item 610), author information (Figure 6, Item

605), and one or more clip-art images (Figure 6, Items 635 & 640); automatically generating a cover page for printing on a first leaf's front-side from the first set of inputs using said software program (The content management application then displays the images and text arranged in the layout of the selected template, Para. 0194), wherein the cover page includes at least one of title information, author information, and one or more clip-art images (Para. 0181-193); accepting a second set of inputs from the user in a second graphical user interface screen and providing them to said software program, the second set of inputs comprising one or more clip-art images (To manage a collection of images in an image library: Point and click the visual assets button, Para. 0206-207) and corresponding text (To Edit an Article: Identify the article's page name in the Name column and click the corresponding edit button in the Function column, Para. 0196-197, See also Figure 7); automatically generating, using said software program, a title page for printing on the first leaf's back-side and a second leaf's front-side, a first story page from the one or more clip-art images from the second set of inputs and a second story page from the second set of inputs including the one or more clip-art images and the corresponding text for printing on a third leaf's front-side (Click a submit button to view the edited article. At this point the article is laid out in accordance with the template that the Author used to create the article, Para. 0209) for printing on the second leaf's back-side and automatically proportionally enlarging the one or more clip-art images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page (In content management and database applications, a template is a blank form that shows which fields exist, and the locations and sizes of the fields. Fields are populated by database-managed text and media that are displayed in a layout determined by the template. A content component of an article can be any of text, a link (text based or image based), or an asset (e.g., image, sound, video, animation). An element of a template is a defined space within which a content component is

rendered, i.e., positioned and displayed, or in the case of an active content component such as an audio clip, executed, Para. 0050-51 ; it is understood that the templates shown in Figure 2 automatically adjust clip art to fit within margins), and allowing the user to print, using the software program, the cover page, the title page, and the first and second story pages (Print module is for producing a hard copy of the published material. It can include, for example, a browser-based application for creating print on demand marketing and business communications, Para. 0117) [Claims 21 & 26].

What Gonzales fails to teach is where the published book is a story book and wherein the title page includes the title and author information; wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page; and wherein the first story page and second story page are printed for binding [Claims 21 & 26]. However, Scocca teaches a storybook publishing kit for children, wherein the title page includes title and author information (As can be seen the cut out section of the cover drawing template is centered so that the drawings will appear in the center of the cover drawing sheet. The area below the arrow on the cover drawing page is where the text will be reprinted from a designated box on the text page form for the cover drawing sheet indicating the title of the book, the author and to whom if anyone the book is being given as a gift, 3:32-39), instructional indicia for indicating how to assemble the book (FIG. 1 is an illustration of the instruction sheet in which the contents of the invention the book publishing kit is listed. The contents of the invention include: a template for the pages of the book; a template for the cover sheet of the book; text pages, preferably three and preferably on yellow paper, for writing the text for each page. two cover drawing sheets or pages with the extra cover sheet provided for mistakes or changes; sheets for the book pages; one set of washable markers; an order form; an illustration or visual sheet which provides information and instruction to the user on how the book will be bound and

published as shown in FIG. 8, 2:13-31 ), and a method of printing the book for binding (Once the pages are drawn and the text written in the boxes of the text page the material can be mailed back to the publisher in pre-addressed envelope included with the kit. The publisher will then match the drawings with the text and print and bind the book. By using templates, the preparation of the book pages and cover drawing sheet is easier and more fun for a child. The completed bound book is mailed back to the home of the child within a number of weeks, 3:40-48). The book publishing templates of the system and method of Gonzales would be adapted to generate a book with the features demonstrated by Scocca, such as generating title page information, such as the title and author of the book, which are old and well-known in the publishing industry. The templates taught by Gonzales would also be adapted to provide a page bearing publishing instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook. Further, the printing function of Gonzales would be reasonably adapted to alternatively allow a user to print the book for binding, if the user possessed a printer and did not wish to mail the manuscript, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include the title and author information on the title page; wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page, as taught in Scocca; in order to assist an amateur author in publishing a professional-looking storybook; and to adapt the printing system and method of Gonzales to allow a user to print the first story page and second story page for binding, taught by Scocca, in order to allow an amateur publisher to print and bind "proof" or "draft" copies of a storybook themselves, without requiring outside assistance or additional postage [Claims 21 & 26].

What Gonzales and Scocca fail to explicitly teach is where the cover page, title page, first story page, second story page, and third story page are oriented in diametric contraposition [Claims 21 & 26]. However, Clements '172 teaches a storytelling book composed of a first or facing side of an "a" side set of pages including a graphic or illustration of a portion of a story, with the "a" sides together and successively illustrating the story, without words and printed text, and a second or back side of a "b" side set of pages including the graphics and illustrations being identical or closely corresponding to the facing {"a" side} graphic or illustration (4:11-30). This page arrangement is understood to be "in diametric contraposition". The publishing templates of the system and method for of Gonzales would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by Gonzales to produce the storytelling book having diametrically opposed story pages, having sets of pages with identical illustrations but with one set omitting the narrative, as taught by Clements '172, in light of the teachings of Scocca, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume [Claims 21 & 26].

What Gonzales, Scocca, and Clements '172 fail to teach is where the title page includes copyright information [Claims 21 & 26]. However, Schubert teaches a recordkeeping book having worksheets for assisting a user in filling in personal information (4:47-52) and step-by-step instructions for completion (1:38-40). Schubert teaches where the front surface of the page is imprinted with general information about the use of the book, including a copyright notice (6:67-7:8). The book publishing templates of the system and method of Gonzales would be adapted to generate a book with copyright information taught by Schubert, which is also old and



well-known in the publishing industry. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added the copyright information to the title page template of Gonzales, as taught by Schubert, further in light of the teachings of Scocca and Clements '172, in order to assist an amateur author in publishing a professional-looking storybook [Claims 21 & 26].

What Gonzales further fails to teach is wherein said one or more indicia include binding instructions [Claims 22, 27, & 32]. However, Scocca teaches instructional indicia for indicating how to assemble the book (2:13-31), and a method of printing the book for binding using templates (3:40-48). The book publishing templates of the system and method of Gonzales would be adapted to provide a page bearing binding instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include one or more indicia for indicating how to bind the story pages, as taught in Scocca, in light of the teachings of Clements '172 and Schubert, in order to assist an amateur author in publishing a professional-looking storybook, without requiring outside assistance or additional postage [Claims 22, 27, & 32].

What Gonzales further fails to teach is wherein said one or more indicia include page numbers [Claims 23, 28, & 33]. However, Scocca teaches where page indicium includes numbering (Figure 6, Item 49). The page numbering of Scocca would be used in the software publishing program templates of Gonzales so that the appropriate box of the text page form can be matched for placing the text with the correct page for illustration, and also to place the pages in the correct order for binding the book. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have included page number

indicia on the pages of the book templates in the system and method of Gonzales, as taught by Scocca, in light of the teachings of Clements '172, in order for a user to match a desired piece of clip art and/or text to a given page when authoring a flip-over story book [Claims 23, 28, & 33].

Gonzales teaches wherein said one or more indicia include graphical symbols (image assets, Para. 0051; understood to be graphics) [Claims 24, 29, & 34].

Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, Scocca, Clements '172, and Schubert, as applied to claims 21 & 26 above, and further in view of Schach et al. (US 5,397,156 A), hereinafter known as Schach.

Gonzales, Scocca, Clements '172, and Schubert teach all the features of claims 21 & 26 as demonstrated above. Gonzales teaches a system and method for producing a storytelling book, comprising a software program in a computer (Para. 0032-44). Scocca teaches a kit for producing a storytelling book, including instructions for binding (2:13-31 and 3:40-48). Clements '172 teaches where the pages of the book are assembled in diametric contraposition (4:11-30). What Gonzales, Scocca, Clements '172, and Schubert fail to teach is where the kit includes a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover [Claim 31]. However, Schach teaches a kit for publishing a personalized paperback romance novel, including a front cover that houses a printed title page, and having author, title, and instruction information indicia thereon (3:12-31 and 4:33-48; see also Figures 1 & 2). The kit including a front cover of Schach would be used to bind, in the fashion taught by Scocca, the pages generated and printed with the templates taught by Gonzales, in order to provide a cover that is otherwise difficult to print or photocopy, e.g. one having an unusual cover, watermark, or printed design in reddish-purple ink, because

the book would be more durable and professional looking if special cover paper is supplied with the kit. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the kit to include a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover, as taught by Schach, with a software program in a computer for publishing the book, as taught by Gonzales, in light of the teachings of Scocca, Clements '172, and Schubert, in order to provide specialized, more durable paper to use for the cover of a storybook [Claims 31-34].

## **(10) Response to Argument**

### **1. The Prior Art References**

Gonzales teaches a computer-implemented interactive publishing system providing content management features enforcing privileges and responsibilities by author, editor, and publisher (Para. 0012). A first embodiment is for managing the content of an article (Para. 0013). A print module is an application for producing a hard copy of the published material (Para. 0117). A second embodiment is for managing the content of a web page, including a module for formatting the web page in accordance with a template (Para. 0014). The system may be employed for hard copy materials, such as brochures or magazines, or for publishing to a web site by posting material to the site (Para. 0032). The pages each include areas designated to contain substantive content, e.g., text and images (Para. 0046; also Figure 6). A content component can be composed of any text or image (Para. 0051). An element of a template designates an area or defined space in which a content component is rendered (Para. 0051-52). Authoring module permits an author to create new content, and to automatically format the article in accordance with the template, for presentation in an element of the template (Para. 0098-99). An author can effectuate a change in the article's layout from one template to

another (Para. 0230). User's access privileges are set based on username by an Administrator (Para. 0036 & 0142). Gonzales allows for the same person to log on to a workstation as an author, editor or publisher using a particular username (Para. 0039).

Scocca teaches a home publishing kit for a children's storybook, providing templates for locating a cover sheet drawing and drawings and text for each page (Column 1, lines 37-44). Scocca provides one or more pages for specifying text and drawings by page (Column 1, line 45-48). The pages of the book kit are sent to a publisher for binding and printing (Column 1, lines 49-51). Instructional indicia is included indicating how to assemble the book (the user's instructions at Figure 1, and the publisher's instructions at Figure 3). The instructions to the publisher include four small boxes indicating the page of the book on which that text is to appear (Column 2, lines 37-41). The cover sheet includes a cover drawing, story title and author information (Figure 8). The page template allows for drawing arrangement and indication of page numbers to place the pages in correct order for binding (Column 2, line 63 through Column 3, line 19).

Clements teaches composing a do-it-yourself story book (Column 3, lines 50-64). The book is disposed with graphics and illustrations depicting the story; the "a" side includes a graphic or illustration of a portion of the story preferably without words or composition; the "b" side includes the identical or closely corresponding graphic on the facing page, of a proportionately reduced size, and textual material constituting a portion of the story corresponding to the graphics (all at Column 4, lines 11-57). In use the storyteller or reader places the book on an easel with "a" pages facing the listener and "b" pages facing the storyteller or reader; such arrangement is termed "diametric contraposition" (Column 4, line 61 through Column 5, line 18). A person may write or illustrate a story of their own on a series of one-sided insertion pages (Column 6, lines 24-26), generated either manually or mechanically

(e.g., using a photocopier or a graphical computer program, Column 6, lines 27-32). The one-sided insertion pages are inserted into clear loose-leaf holders provided in the book in diametric contraposition so that the pages form the "a" and "b" sides of the pages of the book (Column 6, lines 49-67).

Schubert teaches a record-keeping carbon-copy book including step-by-step instructions and data sheets for assembling the book (Column 1, lines 35-43). The front surface is imprinted with general information about the use of the book, including copyright information (Column 6, line 67 through Column 7, line 8).

Schach et al. teaches a kit for personalizing a paperback romance novel, including printed instructions for and a questionnaire for ordering a personalized message in the book, a custom cover or photo page, produced by computer enhancement technology (Column 4, lines 33-48). The personalized book with custom cover is bound by a publisher, then delivered to the customer in accordance with the completed questionnaire (Column 5, lines 17-38).

## **2. The Law Regarding Obviousness**

The Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007), reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), and particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 398, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 398, 82 USPQ2d at 1395. The Supreme Court stated that when considering obviousness of a

combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 398, 82 USPQ2d at 1396.

For purposes of 35 U.S.C. 103, prior art can be either in the field of applicant's endeavor or be reasonably pertinent to the particular problem with which the applicant was concerned. Furthermore, prior art that is in a field of endeavor other than that of the applicant, or solves a problem which is different from that which the applicant was trying to solve, may also be considered for the purposes of 35 U.S.C. 103. *KSR, Id.* At 1397. The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art. The Federal Circuit has stated that examiners and administrative patent judges on the Board are "persons of scientific competence in the fields in which they work" and that their findings are "informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art." *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003).

Once the Graham factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The obviousness analysis cannot be confined by . . . overemphasis on the importance of published articles and the explicit content of issued patents. . . . In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. *KSR, Id.* at 1396.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art." *Id.* In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. Although the Supreme Court in *KSR* cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness.

Once Office personnel have established the Graham factual findings and concluded that the claimed invention would have been obvious, the burden then shifts to the applicant to (A) show that the Office erred in these findings or (B) provide other evidence to show that the claimed subject matter would have been nonobvious. 37 CFR 1.111(b) requires applicant to distinctly and specifically point out the supposed errors in the Office's action and reply to every ground of objection and rejection in the Office action. The reply must present arguments pointing out the specific distinction believed to render the claims patentable over any applied references. If an applicant disagrees with any factual findings by the Office, an effective traverse of a rejection based wholly or partially on such findings must include a reasoned statement explaining why the applicant believes the Office has erred substantively as to the factual

findings. A mere statement or argument that the Office has not established a prima facie case of obviousness or that the Office's reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection or an effective traverse of the rejection under 37 CFR 1.111(b). Office personnel addressing this situation may repeat the rejection made in the prior Office action and make the next Office action final. See MPEP § 706.07(a).

Claims are given their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); Also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data. See MPEP 2106.01. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is



whether there exists any new and unobvious functional relationship between the printed matter and the substrate.") MPEP 2112.01(III).

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed. " *KSR, Id.* Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole.

While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not

criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). MPEP § 2131.05 and § 2145, subsection X.D., discuss prior art that teaches away from the claimed invention in the context of anticipation and obviousness, respectively. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and

the legal conclusion must be reached on the basis of the facts gleaned from the prior art. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR Id.* "If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) "Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function." *In re Dance*, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998). If the proposed modification or combination of

the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). >See also *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick*, 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006) ("Indeed, we have repeatedly held that an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example

because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves.”).

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336; *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991), *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), and MPEP 2145, paragraph II for case law pertaining to the presence of additional advantages or latent properties not recognized in the prior art.

### **3. The References of Record Do Render the Claims Obvious**

The rejection of claims 21-24 & 26-29 is proper because the combined teachings of the references would have suggested to one of ordinary skill in the art to use publishing software such as Gonzales', to compose and print a book having all the indicia taught by Scocca, Clements, Schubert, and Schach; and a person of ordinary skill could have implemented a predictable variation of Gonzales using appropriate templates. The book publishing templates of the system and method of Gonzales would be adapted to generate a book with the features

demonstrated by Scocca, such as generating title page information, such as the title and author of the book, which are old and well-known in the publishing industry. The templates taught by Gonzales would also be adapted to provide a page bearing publishing instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook. Further, the printing function of Gonzales would be reasonably adapted to alternatively allow a user to print the book for binding, if the user possessed a printer and did not wish to mail the manuscript, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include the title and author information on the title page; wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page, as taught in Scocca; in order to assist an amateur author in publishing a professional- looking storybook; and to adapt the printing system and method of Gonzales to allow a user to print the first story page and second story page for binding, taught by Scocca, in order to allow an amateur publisher to print and bind "proof" or "draft" copies of a storybook themselves, without requiring outside assistance or additional postage. The publishing templates of the system and method for of Gonzales would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by Gonzales to produce the storytelling book having diametrically opposed story pages, having sets of pages with identical illustrations but with one set omitting the narrative, as taught by Clements '172, in light of the teachings of Scocca, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume. The book publishing templates of the system and

method of Gonzales would be adapted to generate a book with copyright information taught by Schubert, as is commonly used in the publishing industry. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added the copyright information to the title page template of Gonzales, as taught by Schubert, further in light of the teachings of Scocca and Clements '172, in order to assist an amateur author in publishing a professional-looking storybook. The book publishing templates of the system and method of Gonzales would be adapted to provide a page bearing binding instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include one or more indicia for indicating how to bind the story pages, as taught in Scocca, in light of the teachings of Clements '172 and Schubert, in order to assist an amateur author in publishing a professional-looking storybook, without requiring outside assistance or additional postage. The page numbering of Scocca would be used in the software publishing program templates of Gonzales so that the appropriate box of the text page form can be matched for placing the text with the correct page for illustration, and also to place the pages in the correct order for binding the book. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have included page number indicia on the pages of the book templates in the system and method of Gonzales, as taught by Scocca, in light of the teachings of Clements '172, in order for a user to match a desired piece of clip art and/or text to a given page when authoring a flip-over story book.

Appellant's claims 21, 26, & 31 recite accepting information for composing a book from blank story book screens, and automatically generating by the computer the various pages from the given indicia, and allowing the user to print the generated pages using the computer for

binding in diametric contraposition. The prior art references teach every element of appellant's claimed invention, although separately in various kits for assembling books; it would have been well within the grasp of one of ordinary skill in computer publishing to have used Gonzales to generate a user's blank story web-page screens as authored using Gonzales, and for the user to merely print the web pages so formatted and composed for binding in diametric contraposition, as taught respectively in Scocca, Clements, Schubert, and Schach, using templates as evidenced for such assembling of cover pages, title pages, copyright information, instructions an known in the book publishing industry in diametric contraposition for generating the storybook described in Clements.

**3a. The Combination of the Prior Art References Taken as a Whole Teach What Is Claimed**

**3ai. Gonzales**

The mere fact that appellant argues each reference individually, does not in and of itself indicate that the references are being attacked; however, appellant's argument that Gonzales fails to teach a system for producing a book for storytelling is incorrect because the argument fails to consider the teachings of all the references as a whole, in light of the common knowledge of one of ordinary skill in the art at the time of invention. The teachings of Clements and Scocca for composing such a book would easily be applied to the system of Gonzales for publishing web pages and printing books. Appellant's claimed invention reads into the meaning of book; it would be apparent that many books have been published online, and are available on web sites such as in Gonzales; these books tell stories and would be understood to one of ordinary skill as storybooks. Even the "screens" claimed for input of information imply a web site for applying the claimed method. It is further noted that the limitation "for producing a storytelling



book” is intended use recited in the claim preamble. Such preamble limitations fail to provide structure and thus breathe life and meaning into the claims. It would be well within the contemplation of one of ordinary skill to use layout templates in Gonzales to layout a storybook as described in Scocca, Clements, Schubert, and Schach. The mere content of the text and images applied in a layout is not patentably distinguished merely by being a story or particular instructions for diametric contraposition assembling of pages; such is mere nonfunctional descriptive material, not tied to the substrate; this content is functional only in the subjective mind of the user and fails to change the function of the references as a whole, as Gonzales would be used publish, print, and bind any such content as desired by a user. The content of the instructions specifically is addresses in *Ngai, Id.* and explicitly taught in Clements; it is nonfunctional descriptive material because the contents of the book and instructions fail to change the way the computer program of Gonzales functions; thus, appellant’s arguments are incorrect.

### **3a.iii. Scocca**

Appellant’s arguments concerning the attack against the Scocca reference are incorrect, because Scocca’s book includes instructions for assembling a customized storybook for a user. Scocca teaches instructions both for a user to assemble content for the book (at Figure 1) and instructions written by the user for the publisher to complete the customized book (at Figure 3). Instant claims 21, 26, & 31 nowhere restrict the claims to the instructions being directed to one party or another; Scocca’s instructions at Figures 1 & 3 are broadly and reasonably interpreted as indicia for indicating how to assemble a book, as claimed, because Scocca explicitly instructs a user in “Writing your book pages”; “Making your cover drawing”; and “Sending it to us”, to publish. These are just some examples in where the kit of Scocca for assembling a book

includes assembly instructions. Appellant's further argument that Scocca's instructions does not teach indicia for indicating how to assemble book pages wherein said one or more indicia include page numbers is incorrect because this is clearly taught in Figure 3. Scocca allows a user to specify text and drawings at assigned page numbers. One of ordinary skill in the art would expect the published book to include the specified text and pictures of the completed book to appear at the pages, per user's instruction; the pages being inscribed with indicia indicating the book page, as books are known to be paginated. Appellant is incorrect because it is improper to read these limitations into the claims; further because a printed indicia component of instructions describing assembly of a book by page numbers are also non-functional indicia that fails to distinguish the invention over the instructions Scocca, Clements, Schubert, and Schach.

### **3a.iii. Clements '172**

Appellant also attacks Clements individually because, as asserted, Clements teaches using one-sided insertion pages and page holders; which appellant insists teach away from assembling story pages in diametric contraposition. However, appellant is reading two-sided pages into the term *diametric contraposition*. Whether appellant's claimed invention requires page holders or expects two-sided pages fails to detract from the point that Clement's explicitly teaches what diametric contraposition is. Clements teaches indicia for assembling a storytelling book: instructions to "Paste a reduced size copy of your picture here". Whether "paste" is understood in the context of gluing paper together or electronically copying a file to a given location, it would have been clear to a user of ordinary skill that these are instructions to assemble pictures in a book, whether they are composed on a web page for viewing in a browser, or printed and bound into a hardcopy.

### **3aiv. Schubert & Schach**

Appellant's argument that Schach likewise fails to teach is where a front cover houses a printed cover page is likewise incorrect; despite that the foam cover provided with Schach is a prop; Schach nonetheless teaches instructions to assemble a personalized custom cover with a submitted photo page housed in it. Schach teaches using a computer to generate the cover page. Again appellant is improperly reading in the claims where the instructions are for a user to do the assembling. Further, the subjective content of instructions is functional only in a user's mind; such content fails to patentably alter the function of the invention; as such, the content is properly understood to be non-functional descriptive material, unrelated to the substrate instructions, thus such instructions fail to patentably distinguish over the teachings of Gonzales, Scocca, Clements, Schubert, and Schach.

Appellant refrains from arguing the teachings Schubert separately. Schubert is understood to teach instructions to the user to add copyright information to the title page of a book. This teaching is well within the ordinary skill of any reader of books at the time of invention, thus it would be obvious to have further included in the instructions taught by Gonzales, Scocca, Clements, and Schach for a user to also include indicia in the book relating to copyright information, in manner commonly seen in a professionally published storybook, in order to give the custom book a professional and legal appearance.

### **3b. Gonzales is Analogous Art; The Findings of Obviousness Do Not Change the Principles of Operation of Gonzales**

As evident from the above precedent, the proper test for analogous art is that prior art references must either be in the field of applicant's endeavor or, if not, then be reasonably

pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Gonzales teaches composing and printing a publication, such as a magazine or article. This is reasonably pertinent to the solutions to the same problem of Scocca, Clements, Schubert, and Schach for self-publishing a storybook. Whether a student would find such a system difficult to use has been considered; however, this is mere conjecture on appellant's part and provided without evidence other than opinion. Gonzales as disclosed is evidently simple enough for ordinary users to understand. Appellant's argument that difficulty of use makes Gonzales non-analogous art is thus non-sequiter, because ease-of-use is not the proper test for analogous art. Gonzales teaches a preview of a book as it would appear to a user, when generated automatically using disclosed templates. Gonzales does require that the user supply the text and images manually; however, appellant's invention also requires the user create story text and pictures. Thus, Gonzales is just as automatic as appellant's invention requires and does not change the way the claimed invention.

### **3c. Clements '172 Does Not Teach Away From the Claimed Invention**

As provided in the precedent above, prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives, because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed. Clements teaches using two one-sided printed pages to make one (two-sided) storybook page (all at 6:49-58). This assembly is explicitly disclosed to mean "diametric contraposition" as intended by appellant. Clement's insertion page would merely be generated using a photocopier or a graphical computer as taught (at 6:28-32) when assembling a customized storybook. Thus, Clements does not teach away from the invention as asserted because not disparagement is

made over assembling two-sided storybook pages, because this is in fact what Clements teaches.

**3d. Sufficient Motivation for One of Ordinary Skill in the Art at the Time of Invention to Make Such a Combination Has Been Provided**

Regarding appellant's further argument that valid reasons have not been provided is incorrect because such reasons have been provided. To recap, Gonzales teaches a computer-implemented publishing system for automatically assembling a book using templates; it would have been obvious to use the layouts of the books described in Scocca, Clements, Schubert, and Schach to compose templates in Gonzales for assembling the book of the instant invention automatically, in order to create a professional looking customized book for a user. This express reasoning is reiterated by appellant at pages 32-33 of the brief. When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. KSR, Id., at 1397. There is no requirement that such language or teachings are found within the cited references; only that they are well within the grasp of ordinary common sense. Thus, appellant's argument is incorrect.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/N. A. G./

Examiner, Art Unit 3715

Conferees:

/XUAN M. THAI/

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